

**REMARKS**

Claims 31-58 are pending in the application. In the Office Action,<sup>1</sup> the Examiner took the following actions:

1) rejected claims 31-32, 39, and 42 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits Inc. website ("E-Benefits") in view of U.S. Patent Application Publication No. 2002/0049642 to Moderegger et al. ("Moderegger");

2) rejected claim 33 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of Moderegger and further in view of U.S. Patent Application Publication No. 2002/0023212 to Proudler ("Proudler");

3) rejected claims 34-36 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of Moderegger and further in view of MacSweeny, Gregory, "Billing System Drives Cross-Sell Efforts," Insurance & Technology, June 2003, Vol. 28, Issue 6, p. 23 ("MacSweeny");

4) rejected claims 37-38 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of Moderegger and MacSweeny further in view of Singerman, Frederic S., "The Impact of the Electronic Signatures Act on Plan Administration," Journal of Pension Benefits: Issues in Administration, Autumn 2000, Vol. 8, Issue 1, pp. 3-8 ("Singerman");

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

5) rejected claims 40-41 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of Moderegger and further in view of U.S. Patent Application Publication No. 2003/0229522 to Thompson et al. ("Thompson");

6) rejected claim 43 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits in view of Moderegger and further in view of Tomsen, Mai-lan, "Killer Content: Strategies for Web Content and E-Commerce," Addison Wesley Longman, Inc., Reading, Massachusetts, April, 2000, pp. 13, 129-133, and 177-180 ("Tomsen"); and

7) rejected claims 44-58 for substantially the same reasons as provided above for claims 31-43.

Applicant respectfully traverses the rejection of claims 31-32, 39, and 42 under 35 U.S.C. § 103(a) as being obvious over E-Benefits in view of Moderegger, because a *prima facie* case of obviousness has not been established.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." M.P.E.P. 2142, 8th Ed., Rev. 4 (October 2005), p. 2100-134.

A *prima facie* case of obviousness has not been established because, among other things, neither E-Benefits nor Moderegger, nor their asserted combination, teaches or suggests each and every element of Applicant's claims.

Independent claim 31 calls for a combination including, for example, “automatically receiving the contract document from the service provider associated with the best bid, wherein the contract document includes a status of at least one of accepted, rejected, and amended.” By the Examiner’s own admission, E-Benefits fails to teach or suggest all of the features of claim 31, including those identified above. See Office Action, page 4. However, the Examiner argues that the above recitation of claim 31 “reads on ‘awarding of a contract’ and ‘contract has been awarded’” based on Moderegger at paragraphs [0036] and [0057], respectively. See Office Action, page 5. Applicant respectfully disagrees.

Moderegger is silent with respect to “the **contract document** includ[ing] a status of at least one of accepted, rejected, and amended”, as recited by claim 31 (emphasis added). At paragraph [0036], Moderegger discloses that “the bid prices ... that were accepted in the awarding of a contract ... [are] loaded onto the **database**” (emphasis added). Moderegger further discloses that “the price description field includes ... whether the bid was accepted” (para. [0036]) and that the “**database**] compris[es] ... at least one price description [field]” (para. [0018], emphasis added). Accordingly, Moderegger teaches that the **database** includes whether the bid was accepted in awarding of a contract. Applicant, therefore, submit that Moderegger cannot constitute a teaching of “the **contract document** includ[ing] a status of at least one of accepted, rejected, and amended,” as recited by claim 31 (emphasis added).

In addition, other portions of Moderegger fail to overcome the deficiencies of E-Benefits. For example, at paragraph [0060], Moderegger discloses that “each bidder

is provided the ability to change the prices in a column assigned to him, with the prices typically being lowered by the bidder.” However, this portion of Moderegger refers to the ability of a bidder to change the price of a **bid** before a buyer selects the best bid. Paragraph [0060] of Moderegger, therefore, also does not constitute a sufficient teaching or suggestion of including a status of at least one of accepted, rejected and amended in the **contract document** associated with the best bid.

For the foregoing reasons, the cited references, when taken alone or in any reasonable combination, fail to teach or suggest each and every element of claim 31. For at least this reason, E-Benefits and Moderegger fail to support a *prima facie* case of obviousness. The rejection of claim 31, and dependent claims 32, 39, and 42, under 35 U.S.C. § 103(a) is thus improper and should be withdrawn.

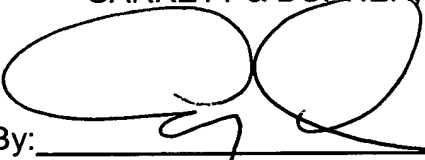
Applicants further traverses rejections of remaining claims 33-38, 41, and 43-58. Independent claims 44, 57, and 58 contain similar limitations to that noted above for claim 31, including the recitation of “automatically receive the contract document from the service provider associated with the best bid, wherein the contract document includes a status of at least one of accepted, rejected, and amended.” Furthermore, claims 33-38, 41, 43, and 45-56 are dependent from independent claims 31 or 44, and thus include all limitations therein. Accordingly, for at least the same reasons stated above for claim 31, claims 33-38, 41, and 43-58 are also allowable over the prior art, including E-Benefits, Moderegger, and the other references applied by the Examiner. Applicant, therefore, respectfully requests a withdrawal of the rejections of claims 33-38, 41, and 43-58.

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of all pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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